IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s):	Levergood et al.
Appl. No.:	09/548,235
Conf. No.:	6069
Filed:	April 12, 2000
Title:	WEB ADVERTISING METHOD
Art Unit:	2155
Examiner:	Patrice L. Winder
Docket No.:	113948-026

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Sir:

This Response is submitted in response to the Office Action dated October 22, 2003.

Claims 1-12.4 are pending in the application. Claims 1,4-6 and 9-11 were rejected under 35 U.S.C. §112 as containing subject matter which was not described in the specification in a way sufficient to enable one of ordinary skill in the art to make or use the invention. Further, claims 1-12 were rejected under 35 U.S.C. §103 as being unpatentable over Lara D. Catledge et al., Characterizing Browsing Strategies in the World Wide Web (Catledge) in view of Bob Novick, The Click Stream (Novick).

Catledge was published at the Third International World-Wide Web Conference, in April, 1995. Novick was posted on the Internet on March 20, 1995. Attached to the present response is an affidavit made by George Winfield Treese, one of the inventors named in the present application. In the affidavit Mr. Treese, having been duly sworn, states that the invention described and claimed in the present invention was conceived and reduced to practice prior to March 20, 1995. Thus, even if the combined teaching of Catledge and Novick taught or suggested the invention claimed in the present application, the articles were not published in this or a foreign country before the date of invention by the Applicant. Accordingly, Catledge and Novick may not be considered prior art for purposes of 35 U.S.C §103(a) against the present application. Therefore, all of the pending claims are allowable over the art of record.

As for the rejection of claims 1, 4-6 and 9-11 under 35 U.S.C. §112, Applicants respectfully traverse. According to the Examiner Applicants have not provided a detailed disclosure of "charging for advertising based on link traversals to the page," with regard to claims 1 and 6, and "measuring the number of sales or transactions resulting from link traversals," with regard to claims 4-5 and 9-11. In both cases the Examiner states that she is aware of the disclosure beginning on page 14 line 24 of the specification and ending on page 15 line 6. However, it would appear that the Examiner has not contemplated the full teaching of this passage. The cited passage is reproduce in full below.

> In another embodiment, the access history is evaluated to determine traversed links leading to a purchase of a product made within commercial pages. This information may be used, for example, to charge for advertising based on the number of link traversal from an advertising page to a product page or based on the count of purchases resulting from a path including the advertisement. In this embodiment, the server can gauge the effectiveness of advertising by measuring the number of sales that resulted from a particular page, link or path of links. The system can be configured to charge the merchant for an advertising page based on the number of sales that resulted from the page.

This rejection has been at issue for some time. The Examiner has continually failed to articulate which aspects of the claims are not sufficiently disclosed by this passage. Short of providing a dictionary definition of the common meaning of every work in the claims, Applicants are at a complete loss as to how within the confines and limitations of the English language, the claims could be any more thoroughly enabled. The terms used in the claims and in the passage quoted above are common English words which, when given their ordinary and customary meaning, fully describe an enabling version of the claimed method. The only remotely technical term in the claims is the term "link," but this term is discussed at length in the specification. There are simply no reasonable grounds for saying that one of ordinary skill in the art would not be enabled to practice the claimed invention based on the disclosure of the specification.

In paragraph 5 of the Final Office Action, the Examiner states that "It is Generally understood that the state of the art at the time of the inventions as understood by the inventor can

be determined by the degree of detail in the disclosure and that which is left for one of ordinarily skill in the art to perform is presumed to be within the skill in the art to perform. As applicant has supplied no detail enabled of the alleged nonobvious process by which to 'charge for advertising based on link traversals to the page" and Measure the number of sales or transactions resulting from link traversals.' Therefore it is presumed to be within the skill of the art." However, this appears to be an argument based on obviousness, and does not shed light on the issue of enablement. These are two distinct inquiries, and issues relating to one (obviousness) should not be allowed to cloud the reasoning relating to the other (enablement).

Since the prior art references relied on by the Examiner in rejecting the pending claims have been overcome by the inventor's affidavit, and since the claimed invention is fully enabled by the specification, the Final Rejection cannot stand and the claims should be allowed.

Respectfully submitted,

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